

means to select one at a time the images he or she desires to have printed and desired services relating to each selected image. In this manner, a simple, non-intimidating display can be used to enter all necessary order information. Other image related services may include Photo CD's, image bearing items such as coffee mugs and T-shirts, and poster sized prints.

Here, Fredlund does not show a number of elements recited in claim 35 and thus cannot render claim 35 obvious. Allowance of claim 35 and those dependent therefrom is requested.

Similarly, independent claim 43 and those dependent therefrom are also patentable over Fredlund. Withdrawal of the Section 102 rejection is requested.

#### The Section 103 Rejection

Claims 12-14, 29-31, 33, 59-76 and 89 were rejected under Section 103(a) as unpatentable over Fredlund and Cok (6,157,436). First, these claims are allowable as they depend from allowable independent claims. Second, page 3 of the Final Office Action agreed that Fredlund disclosed in his invention that orders for each recipient are entered one at a time. The Examiner's characterization of Fredlund actually points away from the obviousness of combining Fredlund and Cok. Fredlund actually points away from the claimed invention since Fredlund can only place an order for one recipient at a time and must repeat the ordering process for each recipient. Fredlund thus cannot receive an order specifying a plurality of recipients all in one step.

Cok relates to an image printing system for generating multiple printed image copies in response to an order. A processor can divide the order into multiple sub-orders for respective image printers, each sub-order having a sub-order header which includes a unique order identification and an indication of the number of copies of the image to be printed by the corresponding printer. A plurality of image printers are connected to the processor, to each receive a corresponding sub-order and print the corresponding sub-order header, and the numbers of image copies indicated in that header.

The Final Office Action noted that "Cok discloses dividing the order to sub-orders for respective image printers. The suborders can be also used for different recipients among other purposes. Fredlund in column 2, lines 1-11 discloses the inconvenience of re-ordering reprints and other image related services is barrier to ordering. Thus ways to improve ordering process

reduces the burden on the customer and encourages repeated and easier use. Thus improving the ordering process is the focus of Fredlund. And by using suborders to process orders for each recipient one can conclude that order processing is made more convenient as desired by Fredlund. Therefore, it can be shown that Fredlund provides the motivation for using suborders since it can facilitate processing of orders more conveniently."

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Cok et al. reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference Fredlund so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. § 2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaack*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

Applicant traverses the comparison. Here, there is no suggestion or motivation in Fredlund to use Cok to arrive at a computer-implemented method of distributing image prints to a plurality of recipients by receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipient.

Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the